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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,485	02/12/2001	Junichi Koshiba	Q63128	8114

7590

07/03/2002

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EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/780,485		KOSHIBA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Hai Vo		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 3-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other:  |

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 2, and 8-10 drawn to a foamed rubber, classified in class 428, subclass 304.4+.
  - II. Claims 3-7, drawn to a process of making a foamed rubber, classified in class 264, subclass 46.4.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as extrusion process.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with J. Frank Osha on 05/30/02 a provisional election was made with traverse to prosecute the invention of Group I, claims 1, 2 and 8-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2, and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 8, the presence of the JIS hardness renders the claims indefinite because the test method is not readily available since it is not in English. Also, since the test method isn't in the specification. Applicant needs to submit the test method and insert it into the specification and show that this was the test as of when the specification was written, i.e., it's not new matter.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mayuzumi et al (US 6,023,597). Mayuzumi discloses a cellular conductive roller comprising a foamed rubber disposed around the outer circumference of a mandrel (figure 1 and column 4, lines 44-47). Mayuzumi discloses the cellular conductive roller having an average cell size of 100 microns (column 5, line 44). Mayuzumi is using the foamed rubber that has the cell size meeting the specific range required by the claims. Since the cell size generally dictates the density and the hardness of the foam, it is the examiner's position that the sponge rubber of Mayuzumi would inherently possess the hardness and density within the ranges set forth in the claims. With regard to claim 9, Mayuzumi is silent as to the modulus strength of the metal core; however, since the cellular conductive roller of Mayuzumi meets all the limitations of structure and chemistry, i.e., a foamed rubber bonded to the core mandrel; a foamed rubber having the cell size meeting the specific range set forth by the claims, it is the examiner's position that the prior art mandrel would inherently have the same modulus strength as the claimed rigid body. Since the USPTO is unequipped to perform the necessary experimentation, the burden to show the prior art mandrel having the modulus strength outside the range as claimed is shifted to Applicant. Mayuzumi anticipates or strongly suggests the claimed subject matter.

10. Claims 1, 2, 8, and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP-11- 080459. JP'459 discloses a sponge roller comprising a sponge rubber disposed around the outer circumference of a metal core (figure 1 and abstract). JP'459 discloses the sponge rubber having an average cell size of 150 microns or less (abstract). JP'459 is using the same material to form a sponge rubber as Applicant, i.e., ethylene-alpha-olefin-non-conjugated diene copolymer and the sponge rubber having the cell size meeting and the cell size meeting the specific range required by the claims. Since the cell size generally dictates the density and the hardness of the foam, it is the examiner's position that the sponge rubber of JP'459 would inherently possess the hardness and density within the ranges set forth in the claims. With regard to claim 9, JP'459 is silent as to the modulus strength of the metal core; however, since the sponge roller of JP'459 meets all the limitations of structure and chemistry, i.e., a foamed rubber bonded to the metal core; a foamed rubber made of the same material as the present invention and having the cell size meeting the specific range set forth by the claims, it is the examiner's position that the prior art metal core would inherently have the same modulus strength as the claimed rigid body. Since the USPTO is unequipped to perform the necessary experimentation, the burden to show the prior art metal core having the modulus strength outside the range as claimed is shifted to Applicant. JP'459 anticipates the claimed subject matter.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP-11-080459 or Mayuzumi et al (US 6,023,597) as applied to claim 8 above, in view of Ikeda et al (US 5,455,296). The primary reference does not disclose the specific material of a metal core. Ikeda discloses a rubber roller having a rubber member bonded to a stainless steel mandrel (column 4, lines 35-38 and column 6, line 34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ stainless steel to form a core metal motivated by the desire to improve the strength and corrosion resistance of the sponge roller.
12. Claims 1, 2, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okita et al (US 6,132,847). Okita discloses a weather strip having U-shaped grip **14** and hollow seal **16** and lip seal **18**, all of which are extruded from the finely foamed rubber that is formed from a blend of EPDM and crystalline PE (figures 1 and 2, column 4, lines 63-66). Okita is silent as to the average cell size of the foamed rubber. However, such a variable would have been recognized by one skilled in the art to prevent the increase in irregularity when any surface coating is applied. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foam of Okita with an average cell size instantly claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Okita does disclose the rubber foam having specific gravity of from 0.9 to 1.0, a surface roughness of 14 microns or less, elongation strength (column 2, lines 27-28, tables 2-4). Since the specific gravity and elongation strength together dictate the hardness of the foam and Okita is using the same material as Applicant to form a weather strip such as EPDM foam, it is the examiner's position that the hardness and the density of Okita foam would be inherently present.

With regard to claim 10, the examiner interprets that the hollow seal and lip seal are analogous to the foamed rubber part of the claimed invention and U-shaped grip analogous to the rigid body. Since all the parts of the weather strip are extruded from the foamed rubber that is a blend of the foamed EPDM and crystalline PE (column 4, lines 63-67), Okita reads on the limitations of claim 10.

With regard to claim 9, Okita is silent as to the modulus strength of the U-shaped grip; however, since the weather strip of Okita meets all the limitations of structure and chemistry (see discussion in claim 10 above), it is the examiner's position that the prior art grip would inherently have the same modulus strength as the claimed rigid body and since the USPTO is unequipped to perform the necessary experimentation, the burden to show the prior art grip having the modulus strength outside the range as claimed is shifted to Applicant.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-



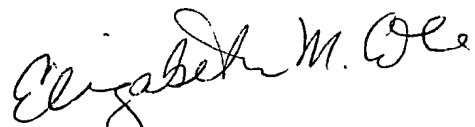
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4426. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00 (EAST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Hai Vo  
June 26, 2002

  
ELIZABETH M. COLE  
PRIMARY EXAMINER